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IN THE

Supreme Court of The United States

OCTOBER TERM, 1965

No. 57

HAZELTINE RESEARCH, INC. and ROBERT REGIS,
Petitioners,

VS.

EDWARD J. BRENNER,
COMMISSIONER OF PATENTS,
Respondent.

PETITION FOR REHEARING

*To the Honorable Chief Justice and the Associate Justices
of the Supreme Court of the United States*

Pursuant to Rule 58, Your Petitioners, by their undersigned attorney, respectfully pray for rehearing and reconsideration of the Decision of this Honorable Court dated December 8, 1965 (— U.S. —) affirming the Judgments of the Courts below.

This Petition is based on the ground that this Court's Opinion is bottomed upon its view of what the law *should be* but is in derogation of Section 103 of the Patent Act of 1952 (Title 35, U.S. Code)*, the most recent Congress-

* Hereinafter referred to as the "Act".

sional pronouncement of the relevant law. This is a new ground advanced by the Court *sua sponte* for affirming the Judgments of the Courts below and one which Petitioners have not had, but should have, an opportunity to refute.

Respondent, in the Courts below and here, rested its case principally on two contentions:

(a) The contention that, because a copending patent "negatives" or is "relevant to" patentability of a later filed application under Section 102(e) of the Act, it is therefore "relevant to patentability" under all other subsections of Section 102 and also under Section 103. This error in Respondent's reasoning is answered in the Reply Brief for Petitioners*, pages 2-5.

(b) The erroneous contention that the invention defined by the Regis claims in issue represented an "insignificant advance" over the disclosure of the Wallace patent alone. The error in this contention is corrected at PRB, pp. 5-7. It is contrary to the express finding of the Trial Court:

"* * * neither the Wallace et al patent, nor the Carlson patent alone anticipates the invention described in the claims in suit." (R. 70A)

The Court, in its Opinion, did not adopt either of these erroneous contentions of Respondent.

The Opinion of the District Court (R. 69A), affirmed by the Court of Appeals *per curiam* (R. 82), was based on essentially three *different* premises:

(a) An erroneous interpretation of *Detrola v. Hazeltine* (1941) 313 U.S. 259 (R. 70A).

* The Reply Brief for Petitioners is hereinafter referred to as PRB—.

(b) The decisions of a number of Appellate Courts (R. 71A) holding contrary to the better reasoned authorities.

(c) A finding that the 1952 Patent Act did not change the law as enunciated by the Appellate Court decisions which it cited (R. 72A-74A).

This Court's Opinion did not adopt or refer to any of the foregoing bases of the District Court's Opinion.

On the other hand, the rationale of this Court's Opinion, as understood by Petitioners, is that, since the copending patentee Wallace filed his application in the Patent Office prior to Regis, the only reason that that patent was not a part of the public knowledge as of the time Regis made his invention was because of the time inevitably required by the Patent Office to process the Wallace application into a patent. The Court further reasoned that, as a matter of public policy, such a copending patent *should be* treated as though it were published as of the date when it was filed in the Patent Office.

Petitioners respectfully urge that the foregoing basis of the Court's Opinion is directly contrary to the express provisions of Section 103 of the Act, as set forth in detail below.

Petitioners heretofore have not had an opportunity to respond to this new ground for denying a patent to Regis and Petitioners should not be foreclosed from such opportunity.

POINT 1. THIS COURT'S OPINION IS BOTTOMED UPON ITS VIEW OF WHAT THE LAW *SHOULD BE* BUT IS IN DEROGATION OF SECTION 103 OF THE PATENT ACT OF 1952 (Title 35, U.S. Code).

In support of its rationale that a copending patent *should be* treated for all purposes as of its filing date, the

Court quotes from *Alexander Milburn v. Davis Bournonville* (1926) 270 U.S. 390:

“* * * ‘The delays of the patent office ought not to cut down the effect of what has been done . . . [The first applicant] had taken steps that would make it public as soon as the Patent Office did its work, although, of course, amendments might be required of him before the end could be reached. We see no reason in the words or policy of the law for allowing [the second applicant] to profit by the delay . . .’ At p. 401.” (pp. 3-4)

In the *Alexander Milburn* case, the issue was *solely* whether a copending patent to one Clifford could be used to show that a later applicant, Whitford, was not the *first inventor* of a single invention disclosed by both parties. This Court emphasized that that was the only issue which it was deciding, saying:

“* * * The fundamental rule we repeat is that the patentee must be the first inventor.” (p. 402)

When applied to the facts of that case, there can be no quarrel with the ruling in the *Alexander Milburn* decision.

However, this Court’s Opinion *extends* the ruling in *Alexander Milburn* to the case in which the copending patent (Wallace) *does not disclose the invention* claimed by the later applicant, but *only a part of it*. In order to meet the Regis claims, it becomes necessary to add to Wallace’s invention the invention of Carlson. This is not an insignificant addition, as evidenced by the grant of a patent on it to Carlson.

We are not here concerned with the question of whether such an extension of the ruling in the *Alexander Milburn* case would have been in consonance with the Patent Statutes at the time of that decision (1926). It is clear however, that such an *extension* of the rule of *Alexander*

Milburn is in *direct conflict* with Section 103 of the Act now in effect. Section 103 reads:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole *would have been obvious at the time the invention was made* to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."
(Emphasis added)

In this case, the "time the invention was made" is the filing of the Regis application in December, 1957. Inescapably, for the subject matter of the Regis application to have been obvious to the man skilled in the art in December, 1957, the knowledge (prior art) from which obviousness is determined must have been available to him and to other workers in the art. It is simply unrealistic to say that an invention would have been obvious to one skilled in the art in the light of subject matter held in secrecy in the Patent Office (Title 35, U.S. Code, Section 122) of which the skilled artisan *could not possibly have knowledge* and knowledge of which could not be imputed to him.

Thus, even though the Regis invention might have been obvious to one skilled in the art *after the Wallace patent issued in 1958, it could not have been obvious to the skilled artisan in 1957* when the Regis invention was made, and that is the test established by Section 103 of the Act.

The Court urges that the "basic reasoning" of the *Alexander Milburn* decision that a copending patent disclosing the complete invention of a later applicant *should be extended to apply to a situation in which the copending*

patent discloses only a part of the invention, quoting in support of this reasoning from *Alexander Milburn*:

“* * * ‘The delays of the patent office ought not to cut down the effect of what has been done.’ P. 401.” (p. 4)

In the factual situation of the *Alexander Milburn* case, the “delays of the Patent Office” and the date of issuance of the copending patent did not in any way affect the fact or the date of the *prior invention* by the copending patentee, the *sole issue* decided in that case. The copending patent merely provided proof of the date and the nature of the *prior invention*—the delay in the Patent Office was immaterial. In recognition of this state of affairs, the *Alexander Milburn* decision was codified in Section 102(e).

On the other hand, when the critical fact is the extent of the knowledge of persons skilled in the art “*at the time the invention was made*”, the extent of such knowledge cannot be *retroactively* changed by adding to it at a later date, *nunc pro tunc*, secret knowledge that was in fact *not* available “*at the time the invention was made*”. It is unrealistic to attribute to one skilled in the art at a particular date knowledge that did not become available until a later date. Whether the delay in the transfer of the knowledge from the secret category to the public domain is due to delay in the Patent Office or to other causes is of no importance.

Petitioners have shown (Brief for Petitioners, pp. 21-25) that the extension of the *Alexander Milburn* decision effected by the Court’s Opinion, putting the information in a secret patent application in the same category as general public knowledge (prior art), violates straightforward logic; it violates the rules of simple fairness; and it serves no public interest. It is submitted that for these reasons such an extension of the *Alexander Milburn* rule *should not* be the law. Moreover, Congress has not seen fit to make it law. Section 103 of the Act, which is

controlling here, simply does not reach such an extension of the *Alexander Milburn* ruling for the reasons pointed out above.

POINT 2. AN INVENTION MAINTAINED IN SECRECY IN A COPENDING PATENT APPLICATION IS ON ALL FOURS WITH AN INVENTION INCORPORATED IN A SECRET PROCESS.

There is another facet of the issue raised by this Petition and that is the relationship between an invention in a pending patent application held in secrecy *by the Patent Office* and an invention maintained in secrecy *by the owner*, often referred to as a secret process. No instance is known to Petitioners in which a secret process has been included in the prior art. At the hearing in this case, in response to a question from the Court, counsel for Respondent effectively conceded that a secret process is not a part of the prior art.

But the "delays of the Patent Office" referred to by Mr. Justice Holmes in the *Alexander Milburn* case, *supra*, in transferring secret information in a copending patent application to the public domain by issuance of the patent, are to a large extent within the control of an applicant for a patent and his attorney. It is a matter of common knowledge that there are various devices by which the pendency of a patent application has been, and may be, materially prolonged. One of the restraints upon such practice is the desire of the patent owner to issue the patent promptly and thus make it available as a part of the prior art to show obviousness of later inventions of competitors.

The ruling of the Court that the subject matter of such a pending application is within the prior art and is thus available to anticipate the invention of a competitor, no matter how long the issuance of the patent is delayed, destroys the restraint on prolonging the pendency of such an application. In fact, such a ruling creates an *inducement* to applicant to keep his application pending, and thus in

secrecy from his competitors, as long as possible, with the foreknowledge that he will not be prejudiced by such a prolonged pendency.

It is in the public interest that patents issue as promptly as possible, since their inventions go into the public domain seventeen years after issue. It is submitted that the ruling of the Court is contrary to public interest in encouraging the prolongation of the pendency of patent applications by applicants and their attorneys.

POINT 3. BY THE ESTABLISHED RULES OF STATUTORY CONSTRUCTION, A COPENDING PATENT IS NOT EMBRACED IN THE PRIOR ART REFERRED TO IN SECTION 103.

There is a cardinal principle of statutory construction which also precludes bringing copending patents, as of their filing date, within the purview of Section 103 of the Act. As the Court's Opinion states (p. 4), the relevance of copending patents, as decided in the *Alexander Milburn* case, was codified by Section 102(e) of the Act, which deals specifically and exclusively with copending patents. Section 103 on the other hand, is general in scope referring to various kinds of prior art, including prior patents, prior publications prior public uses, etc.

It has been consistently held that where a given situation is explicitly covered by a specific section of a statute, another section of the statute of general scope will not be construed to include that specific fact situation. Thus, in *Fourco Glass v. Transmirra Products* (1957) 353 U. S. 222, this Court stated the question presented:

“The question presented is whether 28 U.S.C. §1400 (b) is the sole and exclusive provision governing venue in patent infringement actions, or whether that section is supplemented by 28 U.S.C. §1391 (c).” (p. 222)

As the Court noted, Section 1400 of Title 28 is titled "Patents and Copyrights" while Section 1391 is titled "Venue Generally". In holding that general Section 1391 (c) did not apply to the specific type of action dealt with in Section 1400(b), this Court enunciated the rule:

"We think it is clear that §1391(c) is a general corporation venue statute, whereas §1400(b) is a special venue statute applicable, specifically, to *all* defendants in a particular type of actions, i.e., patent infringement actions. In these circumstances the law is settled that 'However inclusive may be the general language of a statute, it "will not be held to apply to a matter specifically dealt with in another part of the same enactment. * * * Specific terms prevail over the general in the same or another statute which otherwise might be controlling," *Ginsberg & Sons v. Popkin*, 285 U. S. 204, 208.' *MacEvoy Co. v. United States*, 322 U. S. 102, 107." (Emphasis Court's; pp. 228-229)

The ruling in the *Fourco Glass* case is squarely applicable here. Copending patents are "specifically dealt with" in Section 102(e) of the Act. Section 103 is a general section constituting "another part of the same enactment" (66 Stat. 797, 798). It is contrary to established statutory construction to extend general Section 103 to embrace the factual situation dealt with specifically in Section 102(e). As a consequence, a copending patent "specifically dealt with" in Section 102(e) cannot be carried over into the prior art referred to in general Section 103.*

* While Section 103 does contain a reference to Section 102, it is only to the effect that even if the seven subsections of Section 102 do not bar the grant of a patent, still the inventor may not receive a patent if his invention was obvious as defined in Section 103. Section 103 *does not* refer to Section 102 for a definition of the "prior art".

CONCLUSION

For the reasons stated above, it is submitted that the Judgment of the District Court and the Judgment of the Court of Appeals should be vacated and the District Court ordered to enter a judgment pursuant to Title 35, U.S. Code, Section 145 authorizing the Commissioner of Patents to issue Letters Patent to Petitioners on the invention claimed in claims 1, 2 and 3 of the Regis application Serial No. 704,770, as prayed in the Complaint herein.

Respectfully,

LAURENCE B. DODDS
59-25 Little Neck Parkway
Little Neck, New York 11362
Attorney for Petitioners

Of Counsel:

GEORGE R. JONES
425 Thirteenth Street, N. W.
Washington, D. C. 20004

CERTIFICATE

I hereby certify that the foregoing Petition for Re-hearing is presented in good faith and not for delay.

LAURENCE B. DODDS